REMARKS

Claims 1-58 are pending herein. By the Office Action, claims 49-58 are withdrawn from consideration, claims 1, 2, 4-13, 20-25, 27, 30-34, 36-38, and 43-45 are rejected under 35 U.S.C. §103(a), and claims 1-48 are rejected for obviousness-type double patenting.

I. Information Disclosure Statement

An Information Disclosure Statement with Form PTO-1449 was filed on August 11, 2003. Although a copy of the Form PTO-1449 was included with the Office Action, the Form PTO-1449 was not initialed and signed by the Examiner to acknowledge the fact that the Examiner has considered the cited information. The Examiner is requested to initial and return to the undersigned a copy of the subject Form PTO-1449. For the convenience of the Examiner, a copy of that form is attached.

II. Restriction Requirement

Claims 49-58 are withdrawn from consideration as subject to a Restriction Requirement. Applicant respectfully traverses the Restriction Requirement.

The Restriction Requirement is traversed because the claims of Groups I and III are drawn to sufficiently inter-related inventions to warrant examination thereof in a single application. Group I is drawn to a combination including a container and a 1,1-disubstituted ethylene monomer composition contained in said container. Group III is drawn to a method of storing a 1,1-disubstituted ethylene monomer composition in a container. In particular, the container and composition specified in claim 49 (Group III) is the same as the container and composition specified in claim 1 (Group I).

Where product and process claims are presented in the same application, Applicant may be called upon under 35 U.S.C. §121 to elect claims to either the product or process. MPEP §821.04. However, in the case of an elected product claim, rejoinder will be permitted when a

product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim. Id.

In the present application, the method claims of Group III, like the method claims of rejoined Group II, include all of the limitations of the product of Group I. In particular, all of the limitations of the independent product claim 1 of Group I are incorporated into the method of claim 49 (Group III).

Since the method claims of Group III include the limitations of the product claims of Group I, the method claims must be rejoined with the product claims once the product claims are allowed. Thus, to streamline prosecution and avoid delay, the Restriction Requirement should be withdrawn to permit concurrent examination of all of the pending claims. Applicant respectfully requests reconsideration and withdrawal of the Restriction Requirement.

III. Rejection Under 35 U.S.C. §103

Claims 1, 2, 4-13, 20-25, 27, 30-34, 36-38, and 43-45 are rejected under 35 U.S.C. §103(a) over Narang et al. Applicant respectfully traverses this rejection.

Narang is cited as disclosing a polymerizable monomeric adhesive composition, particularly a cyanoacrylate composition, which is stored in a fluorinated polymeric container. See, for example, Narang at col. 12, lines 24-31. Although Narang is silent with respect to the presence or absence of mold release agents in or on the container material, the Office Action asserts that the absence of mold release agents such as zinc stearate would have been obvious to one of ordinary skill in the art. Because the Office Action has failed to establish a *prima facie* case of obviousness, Applicant submits that the rejection must be withdrawn.

The requirements for a *prima facie* case of obviousness are specified and described in MPEP §2143. According to MPEP §2143, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the

reference. Second, there must be a reasonable expectation of success. Third, the prior art reference must teach or suggest all the claim limitations. The reference applied in the Office Action fails to teach or suggest all the claim limitations, and fails to provide any motivation for modification to obtain the claimed invention. Thus, the reference does not establish a *prima facie* case of obviousness.

Claim 1 specifically recites a combination including: a container comprising a polymeric resin matrix including at least one halogenated polymeric material, the container being free from mold release agent; and a 1,1-disubstituted ethylene monomer composition contained in said container. Claim 1 thus requires that the container be free from mold release agents. At least this limitation is neither taught nor suggested in the cited reference.

According to the claimed invention, significant and unexpected results are provided by ensuring that the container is free from mold release agent. For example, the specification describes that in the prior art, mold release agents are conventionally used to facilitate release of a shaped article from a mold and to facilitate the flow of plastic through extrusion orifices. See paragraph [0017]. However, the present inventor has discovered an unexpected interaction between mold release agents, moisture, and radiation sterilization in containers for storing 1,1-disubstituted ethylene monomers. That unexpected interaction when 1,1-disubstituted ethylene monomers are stored at room temperature and moisture conditions, in containers that are comprised of halogenated polymer that have been manufactured using a conventional mold release agent, and the containers are subjected to sterilization, is that the combination of container and product has an unacceptable shelf life. The present inventor has further discovered that if the above conditions are replicated, except that the container is manufactured in the absence of mold release agent, then the combination of container and product has an unexpected and exceptional shelf life. See paragraph [0018]. This interaction

between mold release agents, moisture, and radiation sterilization in containers for storing 1,1-disubstituted ethylene monomers was previously unknown in the prior art.

The cited reference to Narang merely discloses that fluorinated containers can be used to contain 1,1-disubstituted ethylene monomers. However, Narang does not disclose that the containers are free of mold release agent. Nor does Narang disclose that 1,1-disubstituted ethylene monomers are sensitive to mold release agents. Thus, Narang fails to provide any teaching or suggestion that the container should be free of mold release agents, as claimed. Furthermore, Narang provides no motivation whatsoever to modify the described containers to exclude mold release agents. That is, Narang fails to teach or suggest the problem discovered by the present inventor, i.e., the unexpected interaction between mold release agents, moisture, and radiation sterilization in containers for storing 1,1-disubstituted ethylene monomers, or the solution to that problem discovered by the present inventor, i.e., making the container free of mold release agents.

In response to this limitation of the claims, the Office Action baldly asserts, without any support, that "it is generally well known in the art to form containers that do not contain mold release agents, ... particularly when the contents of the container is sensitive to such agents." The Office Action fails to establish, by any prior art reference, either (1) that it is in fact "generally well known in the art" to form containers that are free of mold release agents, or (2) that 1,1-disubstituted ethylene monomers are "sensitive to such agents." The Office Action relies only upon some unspecified alleged prior art to establish obviousness of the claimed invention.

However, the Office Action's position is improper, and the Office Action must cite specific prior art references to establish its asserted obviousness in order to maintain the rejection. See MPEP §2144.03. According to the MPEP, "Official notice" of common knowledge that is well known in the art can be taken only in rare cases. "Official notice

unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known." Id. (emphasis added). For example, the MPEP cautions that "assertions of ... specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art." Id. (emphasis added). Despite these requirements, the Office Action does not provide any support for its assertions that containers are known to be made free of mold release agents, or that 1,1-disubstituted ethylene monomers are sensitive to such mold release agents.

For at least the above reasons, it would not have been obvious to one of ordinary skill in the art to practice the claimed invention. It would not have been obvious, based on Narang alone, to modify the disclosed containers to make them free of mold release agents to provide the unexpected results of the claimed invention. Accordingly, claims 1, 2, 4-13, 20-25, 27, 30-34, 36-38, and 43-45 would not have been obvious over Narang. Reconsideration and withdrawal of the rejection are respectfully requested.

IV. Double Patenting Rejection

Claims 1-48 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-59 of U.S. Patent Application No. 09/430,289. Applicant respectfully traverses this rejection.

As with the above rejection over Narang, the Office Action cites the co-pending application for its disclosure of a polymerizable monomeric adhesive composition, particularly a cyanoacrylate composition, which is stored in a fluorinated polymeric container. Likewise, although the co-pending application is silent with respect to the presence or absence of mold release agents in or on the container material, the Office Action asserts that the absence of mold release agents such as zinc stearate would have been obvious to one of ordinary skill in the art because it is allegedly well known in the art to form

containers that do not contain mold release agents, particularly when the contents of the container is sensitive to such agents. In fact, the co-pending application is the application referenced in the cited passage of Narang, discussed above, and thus suffers from the same deficiencies.

For all of the reasons set forth above, the Office Action has failed to establish that the claimed invention would have been obvious over the claims of the co-pending application. The claims in the co-pending application merely discloses that post-fluorinated containers can be used to contain 1,1-disubstituted ethylene monomers. However, the co-pending application does not disclose that the containers are free of mold release agent, or that 1,1-disubstituted ethylene monomers are sensitive to mold release agents. Nor has the Office Action provided any support for its assertions that the instant claim limitations would have been obvious to one of ordinary skill in the art. The co-pending application, like Narang discussed above, fails to provide any teaching or suggestion that the container should be free of mold release agents, as claimed, or that there is any adverse interaction between mold release agents, moisture, and radiation sterilization in containers for storing 1,1-disubstituted ethylene monomers.

For at least the above reasons, it would not have been obvious to one of ordinary skill in the art to practice the claimed invention. It would not have been obvious, based on the claims of the cited co-pending application alone, to modify the disclosed containers to make them free of mold release agents to provide the unexpected results of the claimed invention. Accordingly, claims 1-48 would not have been obvious over the claims of the co-pending application. Reconsideration and withdrawal of the rejection are respectfully requested.

V. Conclusion

In view of the foregoing remarks, Applicant submits that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

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WPB:JSA

Attachment:
Form PTO-1449

Date: November 10, 2004

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Form PTO-1449 (REV. 8-83) US Dept. of Commerce PATENT & TRADEMARK OFFICE	ATTY DOCKET NO. 109236	APPLICATION NO. 09/980,387
INFORMATION DISCLOSURE STATEMENT (Use several sheets if necessary)	APPLICANT(S) Keith R. D'ALESSIO	
	FILING DATE November 21, 2001	GROUP 1732

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS
		US 2003/0039781 A1	2/2003	D'Alessio et al.		
		5,909,976	6/1999	Maeda		

FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB CLASS
		WO 02/20069 A2	3/2002	WIPO		
		WO 00/26284	5/2000	WIPO		
		EP 0 857 658 A1	8/1998	Europe		

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, etc.)

EXAMINER	DATE CONSIDERED

Examiner: Initial if citation considered, whether or not citation is in conformance with M.P.E.P. 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

Date: August 11, 2003